

### **REMARKS**

Claims 5-14 are currently pending in the case. Claims 8-11 have been withdrawn from consideration. The dependency of claim 12 has been corrected so that it is directed to the elected apparatus claims. New claims 15-21 are presented for consideration.

Claims 5, 7, and 14 stand rejected under 35 U.S.C. § 103 as obvious over U.S. Patent Application Publication No. 2002/0130139, to Shiraishi et al. (Shiraishi), in view of each of U.S. Patent No. 5,344,055, to Richter et al. (Richter), U.S. Patent No. 5,373,967, to Grooms et al. (Grooms), and U.S. Patent No. 5,002,718, to Tanaka et al. (Tanaka). Claims 6 and 13 stand rejected under 35 U.S.C. § 103 as obvious over Shiraishi in view of Richter, Grooms, and Tanaka, and further in view of U.S. Patent No. 4,020,978 (Szczepanski).

Reconsideration of the rejection of claims 5-7, 13 and 14, consideration of claim 12, and favorable consideration of new claims 15-20 are requested.

A significant feature of the bottle in claim 5 is the specific characterization of the thicknesses of the front and rear wall portions and left and right wall portions. The thicknesses are chosen so that the front and rear wall portions can be pressed towards each other by squeezing forces applied by fingers of a user without being significantly warped. The left and right wall portions are elastically deformable by the squeezing forces to allow the front and rear walls to be moved towards each other.

The Examiner cites to Fig. 2b of Tanaka for the disclosure of an allegedly like wall configuration. Significantly, Tanaka teaches away from this construction and discusses Fig. 2b in a hypothetical sense rather than as a structure that is conventionally produced. The pertinent description in Tanaka appears in column 4 in lines 25-35. It is stated therein that "[i]f one wants to make a container having a thick-walled neck portion 20, as shown in FIG. 2a, by a conventional method, uniform wall-thickness distribution is not attained in the body 21 and

instead a thick-walled portion 21a and a thin-walled portion 21b will form, as shown in FIG. 2b. **To avoid this problem**, pre-blowing is usually pre-formed but then only a thin-walled neck portion will result” (emphasis added).

Nowhere does Tanaka address the desirability of having front and rear wall portions that can be pressed towards each other through a squeezing force applied by a user's fingers without these wall portions being significantly warped. To the contrary, Tanaka teaches against such a construction, identifying this shape as a “problem”. Thus, one skilled in the art with the applied patents in hand, including Tanaka, would not be motivated to derive the wall structure as set forth in claim 1 and, based on Tanaka's express teachings, would be directed away from such a construction.<sup>1</sup>

It is also significant to note that the United States Supreme Court has mandated that a reason must be stated why elements from separate patents are combined in making a rejection under 35 U.S.C. § 103. The mere existence of these elements in the same art does not, by itself, make combination appropriate. More specifically, the Court stated in *KSR* that:

A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. . . [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relative field to combine the elements in the way that the claimed new invention does. *KSR*, 127 S.Ct. 1727,1741 (2007).

It is respectfully submitted that in paragraphs 5 and 6, the Examiner has made only a conclusory statement that the combination of each of the references, one with the other, “would have been obvious.” No specific reason is set forth as the Supreme Court has required.

Notwithstanding this, even as combined, the prior art lacks any teaching of certain claim elements.

---

<sup>1</sup> As noted above, it is not clear that the Tanaka structure in Fig. 2b is one that is made in the prior art. Rather, it is presented as an undesired outcome if one attempted to use a particular process to make a thickened neck region.

For example, claim 14 characterizes the front wall portion as rearwardly recessed from the upper and lower connection portions. The Examiner has not addressed this limitation in paragraph 5 of the Action and nowhere is it seen what in the cited prior art the Examiner is relying upon for a disclosure of this limitation.

New claims 15-21 are each based, directly or indirectly, upon claim 5 and recite further significant limitations to further distinguish over the applied art.

Reconsideration of the rejection of claims 5-7, 13 and 14 and allowance of the case are requested.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,  
CLARK & MORTIMER

By

  
John S. Mortimer  
Reg. No. 30,407

Dated: June 11, 2010

500 West Madison Street  
Suite 3800  
Chicago, IL 60661-2562  
(312) 876-2113